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10/709,978	06/10/2004	Lydia Breck	03292.101070.3	3977

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EXAMINER

VEZERIS, JAMES A

ART UNIT	PAPER NUMBER
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3693

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12/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/709,978	Applicant(s) BRECK ET AL.	
	Examiner JAMES A. VEZERIS	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Final Action

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Pre-Exam Formalities

2. Claims 4 and 5 are currently amended.
3. Claims 4-7 are currently pending.

Response to Applicant's Arguments

4. Applicant's arguments, see page 5, filed 8/27/2009, with respect to the 101 rejection of claims 4-7 have been fully considered and are persuasive. The 101 rejection of claims 4-7 has been withdrawn.

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5. Applicant's arguments, see page 5, filed 8/27/2009, with respect to the 112 2nd paragraph rejection of claims 4-7 have been fully considered and are persuasive. The 112 2nd paragraph rejection of claims 4-7 has been withdrawn.

6. Applicant's arguments, see pages 6-9, filed 8/27/2009, with respect to the 103(a) rejection of claims 4-7 have been fully considered but they are not persuasive. Applicant argues that Walker and Chasko fail to teach "1) the merchant receiving a user's account number to process a transaction and requesting a secondary transaction number from the account number provider; and 2) the merchant replacing the account number with the STN and storing a record of the transaction that does not include the account number."

7. In response to the applicant's argument that Walker and Chasko fail to teach the merchant receiving a user's account number to process a transaction and requesting a secondary transaction number from the account number provider, examiner further points to Figure 3a and Column 12 Lines 19-45. In Figure 3a the merchant receives the credit card number, and then in Column 12 Lines 19-45 request an authorization code.

8. In response to the applicant's argument that Walker and Chasko fail to teach the merchant replacing the account number with the STN and storing a record of the transaction that does not include the account number, Examiner reads the claim language differently than from the way the Applicant does. As seen in Claim 4, the language, "maintaining, by the merchant and via at least one processor, a record of the transaction, wherein the merchant replaces the account number with the STN and the record does not include the account number," is unclear in that it is not clear if the

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record of the transaction includes the STN, or if the record of the transaction is stored after the merchant replaces the account number with the STN, therefore not actually storing the STN nor account number. Examiner has read the claim in view of the later meaning. Examiner encourages applicant to amend the claim language to clearly state the record of the transaction includes the STN if that is what is attempting to be claimed. If not examiner believes Walker and Chasko teach the claim as interpreted by the examiner.

Claim Rejections- 35 U.S.C 103(a)

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6163771 to Walker in view of US Patent 6738749 to Chasko in further view of US Patent 5826241 to Stein.

Regarding Claims 4 and 5.

Walker teaches:

receiving, from a merchant and via at least one processor, a transaction authorization request for the transaction, the authorization request comprising a primary account number associated with a primary account; (See Fig. 3a Merchant sends out single-use credit card number for authorization)

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generating, via at least one processor, a secondary account number (STN) and associating the STN with the primary account, wherein the primary account number and STN are different; (See Figs. 11a and 11b, Column 12 Lines 19-45, The issuer generates a STN (the authorization code))

receiving, from the merchant and via at least one processor, a request that a provider of the primary account return the STN in lieu of returning the primary account number; (See fig. 3a, Column 12 Lines 19-45, Merchant request authorization code)

sending, via at least one processor, to the merchant an authorization record referencing the STN, wherein the authorization record does not include the primary account number; (See Column 12 Lines 19-45)

processing, via at least one processor, a settlement request associated with the transaction, wherein the settlement request includes the STN and does not include the primary account number; (See Column 12 Lines 19-45)

Walker fails to further teach:

maintaining, by the merchant and via at least one processor, a record of the transaction, wherein the merchant replaces the account number with the STN and the record does not include the account number.

receiving, from a first party and via at least one processor, a transaction dispute identifying the primary account number and relating to the transaction involving the STN;

retrieving, via at least one processor, transaction information from a database using the primary account number; and

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initiating, via at least one processor, an inquiry, with a second party, that includes the STN, wherein the inquiry does not include the primary account number.

Chasko teaches:

maintaining, by the merchant and via at least one processor, a record of the transaction, wherein the merchant replaces the account number with the STN and the record does not include the account number. (See Figure 5)

Stein teaches:

receiving, from a first party and via at least one processor, a transaction dispute identifying the primary account number and relating to the transaction involving the STN; (See Columns 11-12, Lines 55-8)

retrieving, via at least one processor, transaction information from a database using the primary account number; (See Column 5, Lines 55-67)

initiating, via at least one processor, an inquiry, with a second party, that includes the STN, wherein the inquiry does not include the primary account number. (See Column 12, Lines 1-7)

It would have been obvious to one of ordinary skill in the art to include maintaining a record of the transaction, wherein the merchant replaces the account number with the STN and the record does not include the account number; receiving a transaction dispute identifying the primary account number and relating to the transaction involving the STN; retrieving transaction information from a database using the primary account number; and initiating an inquiry, with a second party, that includes the STN, wherein the inquiry does not include the primary account number.

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as taught by Chasko and Stein since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding Claim 6.

Walker fails to further teach:

determining if a valid approval code is associated with the STN;

charging back to the second party an amount of the transaction, if a valid approval code is not associated with the STN.

Stein teaches:

determining if a valid approval code is associated with the STN; (See Column 12, Lines 1-7)

charging back to the second party an amount of the transaction, if a valid approval code is not associated with the STN. (See Figure 6F)

It would have been obvious to one of ordinary skill in the art to include determining if a valid approval code is associated with the STN, and charging back to the second party an amount of the transaction, if a valid approval code is not associated with the STN as taught by Stein, in the method of Walker since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

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Regarding Claim 7.

Walker fails to further teach:

routing the transaction dispute to a predefined STN queue based at least in part on an industry type associated with the transaction.

Stein teaches:

routing the transaction dispute to a predefined STN queue based at least in part on an industry type associated with the transaction. (See Column 12, Lines 1-7)

It would have been obvious to one of ordinary skill in the art to include routing the transaction dispute to a predefined STN queue based at least in part on an industry type associated with the transaction as taught by Stein, in the method of Walker since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES A. VEZERIS whose telephone number is (571)270-1580. The examiner can normally be reached on Monday-alt. Fridays 7:30am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693

/JAMES A VEZERIS/
Examiner, Art Unit 3693

11/25/2009